

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application No.: 09/965,423
Filing Date: September 27, 2001
Applicants: Ali Rihan et al.
Group Art Unit: 1713
Examiner: Tatyana Zalukaeva
Title: Fast Drying Clearcoat Refinish Composition
Docket Nos.: IN-5501 (BASF)
0906-000311 (Harness, Dickey & Pierce)

Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Reply Brief Under 37 C.F.R. § 41.41

Sir:

This is Appellants' reply to the Examiner's Answer mailed July 31, 2007.

Reply to Examiner's Arguments

1. The Rink patent does not anticipate claims 1-22, because the Rink patent does not disclose any example of acrylic polymer polymerized using the claimed amount of at least about 45% by weight of a cycloaliphatic monomer, based on the total weight of monomers polymerized and having a number average molecular weight of at least about 5000 with the specificity that would allow the skilled artisan to recognize and appreciate it.

Appellants have argued that it is insufficient for anticipation that the Rink reference discloses a coating composition comprising a polyacrylate resin obtained by polymerizing 5 to 80% by weight of a cycloaliphatic monomer with a number average molecular weight of 1000 to 5000 because Appellants have shown special and advantageous properties for their specific coating composition comprising a polyacrylate resin obtained by polymerizing at least about 45% by weight of a cycloaliphatic monomer and having a number average molecular weight of at least 5000.

While the Rink reference teaches generally making coating compositions containing very low molecular weight polyacrylates with cycloaliphatic and hydroxyl group-containing monomers, this disclosure does not tell the skilled artisan how to make Appellants' claimed coating compositions that have particular and different properties from an acrylic that has at least about 45% percent cycloaliphatic monomer and at least about 5000 weight average molecular weight.

The Rink reference does not disclose any coating composition with a specific polyacrylate that meets the present claim elements.

The Rink reference discloses only coating compositions with specific polyacrylates that are rather different from the claimed polyacrylates and do not share the advantageous properties (shorter dry times and shorter tack free times) of the claimed coating compositions.

Appellants respectfully argue that, under the *Crown Operations International Ltd. v. Solutia Inc., Ultradent Products Inc. v. Life-Like Cosmetics, Inc., and Minnesota Mining and Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.* line of cases discussed in the Appeal Brief, the present invention is patentable over the Rink reference despite the broad, generalized discussion of the Rink polyacrylate.

Applicants believe that the arguments of the Examiner's Answer do not speak to this legal principle. Accordingly, Appellant continue to ask that the rejection be REVERSED.

II. Claims 1-16 and 22-25 are patentable over Rockrath et al., U.S. 5,616,678 in view of Rink et al., U.S. Patent No. 5,759,631 because the Rockrath patent, which is directed to high bake, original finish compositions, would not suggest to one of ordinary skill in the art how to obtain the unexpected advantages of Applicants' invention in a refinish coating composition, refinish multi-component coating composition, or refinish method.

The Rockrath coatings are "baked under the baking conditions currently employed in the production-line [i.e., OEM] finishing of cars (30 minutes at 130°C. or 20 minutes at 140°C." Col. 7, lines 24-28. It is an essential property of a refinish coating that it be curable under refinish conditions. The Rockrath composition requires the higher bake temperature of OEM coatings. It is not, therefore, a refinish coating.

To counter the evidence provided by Appellants, and the meaning of "refinish coating" as interpreted in view of Appellants' specification, the Examiner just makes up a definition on page 16 of the Answer ("because the composition of Rockrath is transparent . . . and is coated on top of basecoat . . . the composition of Rockrath is a refinish composition"). The Examiner may see it this way, but the coatings art does not, and such an interpretation is inconsistent with Appellants' specification. The claim element "refinish composition" must be interpreted according to the specification and the understanding of the art, and cannot be disregarded.

Accordingly, Appellants maintain the argument that because the Rockrath patent is not concerned with refinish coating compositions and furthermore, does not address the issue of shortening the “dry to handle time” with which the present invention is concerned, the Rockrath patent is nonanalogous art and is improperly combined in making the present rejection, and ask that the rejection be REVERSED.

- III. Claims 1-3, 5-21, and 23-25 are patentable over WO 97/22646 in view of Rink et al., U.S. Patent No. 5,759,631 because the WO '646 document does not suggest refinish compositions or methods.

As was the case with the Rockrath patent, the WO'646 document does not teach or disclose a refinish composition or method. The Examiner relies again on her self-made definition for “refinish composition,” which is at once unsupported by any evidence and contrary to the evidence that is in the record.

The Examiner also argues that hydroxy-functional acrylate polymers “are well known plasticizers.” Applicants respectfully disagree that hydroxy-functional acrylate polymer are “well known” plasticizers for coatings such as those of the WO'646 document and point out that the Das PCT publication has a hydroxy-functional acrylic polymer as its film forming polymer. Abstract; page 3, lines 7-16. Is it a film-forming polymer or a plasticizer? The Examiner appears to regard the Das publication's hydroxyl-containing acrylic polymer as both (a) the hydroxyl-functional acrylic polymer and (b) the film-forming polymer different from the acrylic polymer of (a) in Appellants' claims.

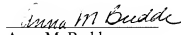
Appellants respectfully submit that the Examiner is reading more into the reference than is there.

Accordingly, Appellants continue to believe the rejection should be REVERSED.

Conclusion

The present claims are patentable over the cited art. Applicants, therefore, respectfully petition this Honorable Board to reverse the final rejection of the claims on each ground and to indicate that all claims are allowable.

Respectfully submitted,



Anna M. Budde
Registration No. 35,085

September 26, 2007
Harness, Dickey & Pierce, P.L.C.
P.O. Box 828
Bloomfield Hills, Michigan 48303
(248) 641-1600